

REMARKS

The Examiner has subjected this application to restriction under 35 U.S.C. 121. The Examiner has formed two groups of claims, the first incorporating claims 1-43 (Group I), drawn to a multilayer film, and the second incorporating claims 44-49 (Group II), drawn to a process for making the multilayer film. The Examiner has asserted that these groups of claims represent distinct inventions and may properly be restricted. Applicants hereby provisionally elect claim Group I directed to claims 1-43 for examination. However, the restriction requirement is traversed. It should be noted, the Commissioner may statutorily require the election of inventions "[i]f two or more independent and distinct inventions are claimed in one application." In the instant case the Examiner is alleging that the inventions of groups one and two are distinct, although absolutely no showing of such distinctness has been made.

The Examiner's attention is directed to 37 C.F.R. 1.141(b) where allegedly different classes of inventions may be included and examined in a single application provided they are so linked as to form a single inventive concept. Please note that claims for a product are specifically authorized for examination together with claims for one process specially adapted for the use of that product. This is exactly the type of case for which the rule was promulgated, i.e., to avoid burdensome and unnecessary restrictions. It is also asserted that the requirement to restrict the present application would be an unnecessary burden upon the Applicants and the Examiner's failure to follow the mandates of the statute and regulation would be a denial of due process. For these reasons it is respectfully urged that the restriction requirement be rescinded.

In addition since the method claims contain all of the limitations of the article claims, the method claims should be rejoined under *In Re Ochiai*, 37 USPQ2d 1127 and *In re Brouwer*, 37 USPQ 1663.

The Examiner has objected to the drawings because the serial number of the application does not appear on the drawing page. It is respectfully submitted that the objection is improper. The standards for drawings are set forth in 37 C.F.R. § 1.84. While subsection 37 C.F.R. § 1.84(c) states that identifying indicia "*should*" be provided on drawing sheets, this is not a mandatory requirement under the patent rules, and an Applicant's failure to include such identifying indicia is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn.

The Examiner has objected to the abstract of the disclosure because the serial number of the application does not appear on the abstract page. It is respectfully submitted that the objection is improper. The requirements for the abstract of the disclosure are set forth in 37 C.F.R. § 1.72 and MPEP § 608.01(b), neither of which includes a requirement for the serial number of the application to appear on the abstract page as the Examiner requires. It is respectfully submitted that this is not a mandatory requirement under the patent rules, and an Applicant's failure to include such identifying indicia is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn.

The Examiner has objected to the Applicants' incorporation by reference of U.S. patents 4,510,301 and 4,544,721, stating that the incorporation is ineffective because these patents do not appear on an Information Disclosure Statement (IDS). It is respectfully submitted that the objection is improper. The requirements for incorporation by reference are set forth in 37 C.F.R. § 1.57 and MPEP § 608.01(p), neither of which includes a requirement for the incorporated patents to be included on an IDS as the Examiner requires. It is respectfully submitted that this is not a mandatory requirement under the patent rules, and is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn. Nonetheless, for the Examiner's convenience, Applicants hereby submit an additional Information Disclosure Statement together with this Amendment including U.S. patents 4,510,301 and 4,544,721, as the Examiner has requested. Applicants submit that no fee is due to submit this IDS due to the Examiner's request.

The Examiner has rejected claims 30-33, 35-36 and 38-39 under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,656,601 to Kawachi et al. Claims 30-39 are hereby canceled.

The Examiner has rejected claims 1-28 and 40-42 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent application 2003/0008152 to Tsai et al. in view of Kawachi et al. It is respectfully submitted that the rejection is not well taken.

The invention provides multilayered films comprising a fluoropolymer layer attached to a thermoplastic polymer layer via an intermediate adhesive tie layer, which adhesive tie layer comprises an adhesive combination of at least one tackifier and at least one ethylene/alpha-olefin copolymer. The adhesive composition adheres layers of such dissimilar polymeric materials that are otherwise incompatible.

Kawachi et al. teaches an adhesive composition which includes an ethylene/ α -olefin copolymer and a tackifier. The adhesive compositions of Kawachi et al. may be formed into an adhesive layer for multilayer laminates, the adhesive layer having good adhesive force to polystyrene resins, ABS resins, polyacrylonitrile resins and ethylene vinyl acetate copolymer saponified resins. Kawachi et al. does not teach that their adhesive compositions are capable of adhering to fluoropolymer films.

Tsai et al. discloses multilayer moisture barrier films useful as packaging materials. More particularly, Tsai et al. describes multilayer barrier films that comprise a fluoropolymer layer attached to a cyclic olefin polymer layer via an intermediate adhesive tie layer. As the Examiner acknowledges, Tsai et al. fails to disclose the adhesive compositions of the presently claimed invention. More specifically, Tsai et al. fails to teach an adhesive comprising a tackifier and an ethylene- α -olefin copolymer.

To fill this void, the Examiner has applied Kawachi et al. It is respectfully submitted that the Examiner has improperly combined the references. Kawachi et al. does not describe film structures that include a fluoropolymer layer. Moreover, while Tsai et al. does describe fluoropolymer layer containing multilayer film structures, the reference describes different adhesive layer compositions than the adhesive compositions described by the claimed invention. Importantly, there is no teaching or suggestion in either reference to combine the multilayer films disclosed by Tsai et al. with the adhesive compositions described by Kawachi et al. Particularly, there is no evidence in the Kawachi et al. reference that their adhesive compositions would even be compatible with fluoropolymers, let alone be sufficient to adhere fluoropolymer layers with other polymeric layers. Accordingly, it is respectfully submitted that one skilled in the art would not look to the Kawachi et al. reference in combination with the Tsai et al. reference to arrive at the presently claimed invention. For these reasons, it is requested that the rejection be withdrawn.

The Examiner has rejected claims 29 and 43 under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. in view of Kawachi et al. and further in view of U.S. patent 6,849,314 to Jing et al. It is respectfully submitted that the rejection is not well taken.

Tsai et al. and Kawachi are discussed in detail above and those arguments are repeated herein. Jing et al. teaches fluoropolymer blends and multilayer articles, such as tubes. In the first instance, the Examiner is directed to col. 1, lines 30-31 where Jing acknowledges the known difficulty in the art of bonding fluoropolymer layers to non-fluoropolymer layers. Such exemplifies the need in the art for Applicants' invention, particularly, a novel adhesive composition which is capable of adhering fluoropolymer layers to virtually any thermoplastic polymer layer. In recognition of this problem, Jing et al. teaches many film structures, most of which include fluoropolymers in each film layer. The structures of Jing et al. are different than those described by applicant, and the reference particularly fails to teach a multilayer film comprising a fluoropolymer layer being attached to a non-fluoropolymer layer via a non-fluoropolymer containing adhesive

tie layer, or more importantly, a tie layer including an ethylene/ α -olefin copolymer and a tackifier. It is further respectfully submitted that the disclosure of Jing et al. fails to overcome the deficiencies between Tsai et al. and Kawachi et al. For these reasons it is requested that the rejection be withdrawn.

The Examiner has rejected claims 34 and 37 under 35 U.S.C. 103(a) over Kawachi et al. It is respectfully submitted that the rejection is moot in view of the cancellation of claims 30-39.

Applicants submit that the Examiner is looking beyond the teachings of the references. The belief that one skilled in the art **could** form the claimed multilayered film does not suggest that one **should** form such a film to obtain the disclosed benefits. The mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Such a suggestion is absent in each of the references.

In determining a *prima facie* case of obviousness, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). To do so, the applied prior art must be such that it would have provided one of ordinary skill in the art with both a motivation to carry out the claimed invention and a reasonable expectation of success in doing so. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). The Kawachi et al. and Tsai et al. references fail to provide such motivation.

It is further respectfully submitted that the Examiner is reconstructing the art in light of Applicants' disclosure. The point in time that is critical for an obviousness determination

is at the time the invention. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the Applicants' achievement, that must establish the obviousness of the combination. Where Applicants' teachings are needed to find the invention, the invention is not obvious.

In the instant case, the motives in the references, as disclosed by the practices therein, are quite different from those in the instant invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (CAFC 1987). There is simply nothing in the cited references to suggest to someone skilled in the art that these teachings should be combined in order to achieve this result.

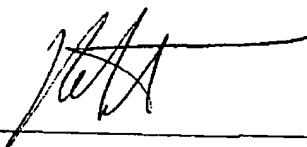
The Examiner has failed to show the linchpin to connect the art and has failed to show a suggestion in the art rather than from an unsupported subjective conclusion, to form the claimed structure. The ancient argument that a building design is not obvious in view of a pile of bricks and mortar from which it is constructed, is equally applicable here. Citing references that merely indicate that isolated parts recited in the claims are known is not a sufficient basis for a conclusion of obviousness; there must be something that suggests the desirability of combining the references in a manner calculated to arrive at the claimed invention. *Ex parte Hiyamizu*, 10 U.S.P.Q.2d 1393, 1394 (PTO Bd. Pat. Ap. and Int., 1988).

In addition, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schneck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). It is respectfully asserted that the invention as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made.

For the foregoing reasons, it is respectfully submitted that the claims are not obvious in view of the Tsai et al. and Kawachi et al. references, either alone or in combination. It is therefore requested that the rejection be withdrawn.

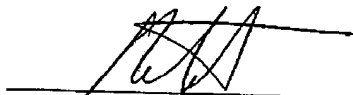
The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (FAX No. 571-273-8300) on January 6, 2006.



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